

REMARKS

This communication responds to the Final Office Action mailed on January 8, 2007 and the Decision on Appeal mailed February 3, 2009. Claims 1, 10, 18 and 22 are amended, no claims are canceled, and no claims are added in this communication. As a result, claims 1-24 are now pending in this application.

It is noted that the amendment to claims 1, 10, 18 and 22 is for the reasons of clarity, but not for the reasons of patentability.

§102 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 102(b) for anticipation by Sacks (U.S. Publication No. 2002/0016765 A1). Applicant respectfully traverses the grounds for rejection for the reasons argued below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

The Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because Sacks does not disclose each and every element of Applicant’s claims arranged as in the claims.

Amended claim 1 reads as follows (with emphasis added):

1. A computer-implemented method comprising:
receiving, from a shopping cart application, detailed information concerning one or more items placed by a user in **a virtual shopping cart hosted by a merchant web site, the shopping cart application being hosted by the merchant web site, the merchant web site being separate from an online payment service**, the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items; and
upon receiving the detailed information from the shopping cart

application, communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items by the online payment service, the one or more user interfaces allowing the user to view content of the virtual shopping cart.

The Applicant respectfully submits that Sacks fails to disclose the limitations of **a virtual shopping cart hosted by a merchant web site separate from the online payment service** and **the shopping cart application being hosted by the merchant web site separate from the online payment service** as claimed in amended claim 1.

First, Sacks does not disclose **a virtual shopping cart hosted by a merchant web site separate from the online payment service** as claimed in claim 1, because in contrast to claim 1, the shopping cart of Sacks is hosted by a **payment processor** (rather than a **seller web site**). Sacks and the claimed Application work in different approaches. In Sacks, payment processor (rather than seller) provides a shopping cart to track a buyer's purchases. For example, referring to Sacks, para 0028, 0034 and 0036, which are reproduced below:

“In another embodiment, **payment processor 106 may provide a third-party shopping cart to track the buyer's purchases**. Thus, in this embodiment, when a buyer's connection is redirected, the buyer may be presented with a shopping cart managed by the payment processor.” (para 0028 of Sacks)

“**Database 210 stores** various user information concerning buyers and sellers, such as account information, **buyer shopping carts**, HTML code for sellers, etc.” (para 0034 of Sacks)

Furthermore, for at least the same reason, Sacks does not disclose **the shopping cart application being hosted by the merchant web site separate from the online payment service** as claimed in amended claim 1 either. It is also noted that both of the Office Actions mailed in 11/30/2005 (page 4, para 1) and 06/13/2006 (page 4, para 2) admit that in Sacks “**it is not fully clear that shopping cart application is external to the payment processor, per se.**” Thus, Sacks cannot disclose **the shopping cart application being hosted by the merchant web site separate from the online payment service** as claimed in amended claim 1.

Therefore, the Applicant respectfully submits that Sacks does not disclose each and every element of claim 1 of the present application, thus Sacks does not anticipate claim 1.

The above argument presented with respect to amended independent claim 1 also applies to independent claims 10, 18 and 22, which have similar features to amended independent 1.

Thus, the Applicant submits that Sacks does not anticipate amended independent claims 10, 18 and 22 either.

Claims 2-9, 11-17, 19-21, and 23-24 each depend, directly or indirectly, on one of claims 1, 10, 18, or 22. For at least the reasons discussed above for claims 1, 10, 18, or 22, the Applicant submits that Sacks does not anticipate these dependent claims.

Therefore, the Applicant respectfully requests the withdrawal and reconsideration of the rejection of claims 1-24.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

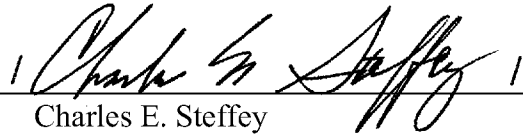
The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's representative at 612-373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-373-6900

Date 03 April 2009

By 
Charles E. Steffey
Reg. No. 25,179

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of April, 2009.

Chris Bartl
Name


Signature